

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Michael John REED et al

U.S. Serial No. : 10/674,892

Filing Date : September 30, 2003

For : COMPOUND

Art Unit : 1617

Examiner : Barbara P. Badio

Confirmation No. : 4836

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FILED VIA EFS-WEB
ON MAY 3, 2007

SUPPLEMENTAL RESPONSE AND RESPONSE TO EXAMINER INTERVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 223133-1450

Dear Sir:

The Examiner is thanked for the courtesies extended during the 3 May 2007 personal interview between the Examiner and Thomas J. Kowalski, Esq.

The Interview Summary is correct that Applicant's representative argued that the double patenting rejections are overcome by the unexpected results of the invention.

More in particular, as discussed during the interview:

(i) The standard for overcoming an allegation of obviousness - whether it be by way of a Section 103 rejection or an obviousness-type double patenting rejection - is the same (and in "obviousness-type double patenting only has statutory basis in 35 USC 103 such that the standard must be the same).

(ii) Having overcome the former Section 103 rejections, Applicants overcame the double patenting rejections, ie, the data and arguments that the Examiner agrees shows nonobviousness such that the Section 103 rejections are withdrawn (see August 17, 2006 Amendment, pages 13-16), thereby shows nonobviousness to overcome the double patenting rejections. And hence the double patenting rejections should be reconsidered and withdrawn.

(iii) For instance, as discussed during the Interview, the Examiner rejected claims as obvious over Reed, WO 93/05064, published from PCT/GB92/01587; and withdrew that rejection in view of the arguments and data previously presented. The double patenting rejection is based on US Patent No. 5,830,886. The 886 patent issued from US application Serial No. 458,352, filed June 2, 1995 as a division of US application Serial No. 196,192, filed as PCT/GB92/01587 - the very same document from which W092/05064 was published, such that the 886 patent and Reed W093/05064 have the same disclosure. (Indeed, during the interview, the Examiner pointed to 886 claim 7 with respect to the double patenting rejection; and Applicants' representative pointed to W093/05064 claim 5 as paralleling 886 claim 7 and demonstrating that the disclosure of the 886 patent - including its claims- was fully considered overcome by the Examiner and that the claims previously granted were considered overcome by Applicants having overcome the previous Section 103 rejection.).

(iv) Therefore, while Applicants respectfully disagree with the form and substance of the double patenting rejections and based thereon assert that the double patenting rejections necessarily must fail, eg, that the Examiner in such a double patenting rejection must identify particular claim or claims of the cited patents or co-pending applications and must identify particular claims of the instant application which are allegedly obvious (which the Office Action fails to do) and that in making such a double patenting rejection the Office action cannot rely on method claims to assert that a compound claim is allegedly obvious (which is now what is understood from the interview wherein the Examiner directed attention to all claims of the pending application and claim 7 of the

886 patent) and that in making the double patenting rejection the Office Action must rely on the patent claims and cannot "fill in" by selective picking and choosing from disclosure in the patent, Applicants also overcome the double patenting rejections because the subject matter of the claims and disclosure relied upon by the Examiner in making the double patenting rejections was before her already, eg, by way of Reed W093/05064; and the Examiner has agreed that the claims are patentable - nonobvious - over those claims and subject matter, by virtue of the withdrawal of the previous Section 103 rejection.

In view of the arguments of record and those during the Interview, including as set forth herein, the Examiner is thanked for - as set forth in the Interview Summary - "agree[ing] to reconsider the [double patenting] rejections," and withdrawal of the double patenting rejections, with prompt issuance of a Notice of Allowance are earnestly solicited. If any issue remains as an impediment to allowance, the Examiner is invited to telephonically contact the undersigned for a further interview with a view towards reaching agreement on allowable subject matter, free of any double patenting rejection

Respectfully submitted,
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